



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/550,331

02/22/2007

Adrienne S. Gordon

12101-013-999

2103

20583

7590

07/20/2009

JONES DAY  
222 EAST 41ST ST  
NEW YORK, NY 10017

EXAMINER

CORNET, JEAN P

ART UNIT

PAPER NUMBER

1614

MAIL DATE

DELIVERY MODE

07/20/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/550,331	<b>Applicant(s)</b> GORDON ET AL.	
	<b>Examiner</b> JEAN CORNET	<b>Art Unit</b> 1614	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,21,36,58,78,86,93,95,118,119,134,137,142 and 145 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____.                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1,21,36,58,78,86,93,95,118,119,134,137,142 and 145.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, drawn to a method of mitigating one or more symptoms associated with chronic consumption of a substance of abuse by a mammal comprising administering an effective amount of an adenosine receptor antagonist, an effective amount of a dopamine receptor antagonist.

Group II, claim(s) 21,134 and 137, drawn to a composition/a kit comprising an effective amount of an adenosine receptor antagonist, an effective amount of a dopamine receptor antagonist.

Group III, claim(s) 36, drawn to a method of mitigating one or more symptoms associated with withdrawal associated with cessation of consumption of a substance of abuse comprising administering to a mammal an effective amount of an adenosine receptor agonist and an effective amount of a dopamine receptor agonist.

Group IV, claim(s) 58,142 and 145, drawn to a composition/kit for mitigating a symptom of withdrawal from a drug of abuse comprising an effective amount of an adenosine receptor agonist and a dopamine receptor agonist.

Group V, claim(s) 78, drawn to a method of mitigating one or more symptom associated with chronic consumption of a substance of abuse comprising inhibiting expression or activity of a beta/gamma dimmer.

Group VI, claim(s) 86, drawn to a method of mitigating consumptive behavior or craving after withdrawal of a substance abuse comprising administering to a mammal an agent that increases effective adenosine levels or activity of an adenosine receptor.

Art Unit: 1614

Group VII, claim(s) 93, drawn to a method of mitigating consumptive behavior or craving during chronic consumptive of a substance of abuse comprising administering to a mammal an adenosine receptor antagonist .

Group VIII, claim(s) 95, drawn to a method of screening for an agent that modulates the effect of a substance of abuse on PKA activation in a mammal comprising contacting a mammalian test cell with a test agent and detecting the expression or activity of a beta/gamma dimmer or said test cell.

Group IX, claim(s) 118, drawn to a method of screening for an agent that decouples dopamine receptor activity from an adenosine receptor pathway.

Group X, claim(s) 119, drawn to a method of prescreening for an agent that modulates the effect of a substance of abuse on activation in a mammal comprising contacting a beta/gamma dimmer or a nucleic acid that encodes a polypeptide comprising a beta/gamma dimmer with a test agent and detecting specific binding of said test agent to a beta/gamma dimmer.

2. The inventions listed as Groups I-X do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: they are unified by a single inventive concept. The Groups are drawn to seven different Groups that do not share a common component. As there is no subject matter common to all the Groups, they lack inventive unity a priori. For example, Groups I is related to a method of mitigating one or more symptoms associated with chronic consumption of a substance of abuse comprising administering an effective amount of an adenosine receptor antagonist, and effective amount of a dopamine receptor antagonist whereas Group VIII is related to a screening method comprising contacting a mammalian test cell with a test agent and detecting the expression or activity of a beta/gamma dimmer or said test cell.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**

Art Unit: 1614

**in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEAN CORNET whose telephone number is (571)270-7669. The examiner can normally be reached on Monday-Thursday 7.00am-5.30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JC/

/Ardin Marschel/  
Supervisory Patent Examiner, Art Unit 1614

Application/Control Number: 10/550,331  
Art Unit: 1614

Page 6